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402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: David G. McCarthy : Examiner: B. Hammond
: :
Title: Retractable Receptable For : Group Art Unit: 2833
Furniture : :
Serial No. 08/951,276 : :
Filed: October 16, 1997 : :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Mail Stop Appeal Brief - Patents

TRANSMITTAL OF REPLY BRIEF

Enclosed for filing is Applicant's Reply Brief (in triplicate) in response to the Examiner's Answer mailed on June 14, 2005, in connection with the pending Appeal of the above identified patent application.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

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REPLY BRIEF

This Reply Brief is being filed in response to the Examiner's Answer, mailed on June 14, 2005.

Section (11), pages 6 - 8, of the Examiner's Answer responds to the arguments advanced by Applicant in the Appeal Brief filed on March 3, 2005.

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1). At page 6, first paragraph of the Examiner's Answer, the Examiner responds to Applicant's argument at page 9, lines 14 - 18 of the Appeal Brief that "...modification of the Byrne patent would defeat the intended purpose and express objective of the arrangement of the structure disclosed by Byrne...". The Examiner disagrees with Applicant's argument and states, in a conclusory manner, that "...The top of Byrne could/would fit in the recess 16 taught by Mitchell to provide an uninterrupted surface." As discussed more fully at pages 8 - 9 of Applicant's Appeal Brief, the structure disclosed by the Byrne patent is arranged to enable the bottom surface of a collar 116 to provide a supporting surface for the housing 108 by permitting the outer perimeter of the collar 116 to overhang the slot 102. Therefore, providing Byrne with a top surface of the collar which is flush with the working surface 104 would defeat the intended purpose and express objective of the arrangement of structure disclosed by Byrne.

Even if the Examiner's conclusion that the top of Byrne could/would fit in the recess taught by Mitchell to provide an uninterrupted surface, this is not the standard by which patentability is determined. Whether selected portions of different references can be combined physically to reconstruct Applicant's claim is irrelevant to the patentability determination. The only issue to be determined is if there is a suggestion or motivation in the prior art itself to combine the references as proposed by the Examiner in the final action. If

no suggestion or motivation to combine the references is present in the prior art, the fact that different structure disclosed by the different references can be combined physically to reconstruct Applicant's claims (particularly where the combination uses Applicant's own disclosure as a guide), does not render the claims obvious. See, Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997); In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992); and Orthopedic Equipment Co. v. United States, 217 USPQ 193 (Fed. Cir. 1983). Also see Datascope Corp. v. SMEC, Inc., 227 USPQ 838 (Fed. Cir. 1985) in which the Court held that whether prior art disclosures could physically be substituted in a combination like that claimed in the patent is irrelevant in determining obviousness under Section 103; and In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984) in which the Court held that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. Also, as noted by the Court in Tec Air, Inc. v. Denso Manufacturing Michigan Inc., 52 USPQ 2d 1294 (Fed. Cir. 1999) and Winner International Royalty Corp. v. Wang, 53 USPQ 2d 1580 (Fed. Cir. 2000), there is no suggestion to combine references if a reference teaches away from the combination. Therefore, a combination which defeats the intended purpose or objective of one of the combined references is not suggested by the prior art itself.

2). At page 6, second paragraph of the Examiner's Answer, the Examiner addresses the arguments presented by Applicant at page 10, lines 22 - 26 of the Appeal Brief. This argument advanced by Applicant relies upon authorities, such as those cited above, for the proposition that references cannot be combined to reject a claim in the absence of a suggestion or motivation in the prior art itself to make the combination. Applicant reiterates the position advanced in its Appeal Brief that as result of the diverse teachings of the individual disclosures of the combined references, there is clearly no suggestion or motivation in the prior art itself to combine the references as proposed in the final action. On the contrary, as a result of the diverse teachings of the references (as noted above, the combination defeats an intended objective of one of the combined references), the only basis for the combination must be derived from the improper use of Applicant's own disclosure as a guide for combining the right portions of the right references in the right way.

3). At page 7, first paragraph of the Examiner's Answer, the Examiner addresses the arguments advanced by Applicant at page 12, line 1 of the Appeal Brief, directed to the rejection of independent Claim 1 as being obvious over the Mitchell et al. patent alone. The Examiner concludes that the claim is obvious over the disclosure of Mitchell et al. because Mitchell et al. discloses a removable cover placed over an opening in a working surface when a housing is recessed below the working surface to

provide an uninterrupted working surface. The differences in structure and structural arrangement between Applicant's claim and the disclosure of the Mitchell et al. patent are discussed at page 11, first full paragraph of Applicant's Appeal Brief. The modifications to the structure and structural arrangement of the disclosure of the Mitchell et al. patent necessary to result in the article of furniture defined by Applicant's independent Claim 1 are discussed at page 12 of Applicant's Appeal Brief. The Examiner's Answer fails to respond to these specific arguments advanced by Applicant in its Appeal Brief establishing that there is no suggestion in the prior art itself to modify the disclosure of Mitchell et al in the manner proposed by the Examiner in the final action.

4). At page 7, second paragraph of the Examiner's Answer, the Examiner refers to Applicant's argument on page 13, line 6 of the Appeal Brief, that the structural arrangement of Mitchell is different from the article of furniture defined by independent Claim 1, but contends that Applicant has not identified the patentable differences. Applicant respectfully disagrees with the Examiner since pages 11 - 12 of Applicant's Appeal Brief, as noted above, clearly discuss the numerous reasons why the structure and structural arrangement recited in independent Claim 1 is patentably distinguishable from the disclosure of the Mitchell et al. patent.

5). Still referring to page 7, second paragraph of the Examiner's Answer, the Examiner appears to be making a general statement that Applicant's arguments fail to point out the reasons why Applicant considers the appealed claims to be patentably distinguishable over the prior art applied to reject the claims, and how the appealed claims avoid the applied prior art references. Applicant respectfully disagrees with the Examiner's statement. On the contrary, the Applicant's Appeal Brief, at pages 7 - 14, has presented detailed factual and legal arguments distinguishing appealed independent Claims 1, 16 and 19 over the prior art applied to reject these claims.

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For the reasons discussed herein and throughout the prosecution of this patent application, including the Request For Reconsideration After Final Rejection filed on November 26, 2004, Applicant respectfully submits that all of the appealed independent Claims 1, 16 and 19 are allowable over the prior art applied in the final action, and that the rejection of the appealed claims over the applied prior art should be reversed.

Respectfully submitted,



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